

Appl. No. 10/706,104
Docket No. 9118M
Amdt. dated July 10, 2009
Reply to Office Action mailed on March 16, 2009
Customer No. 27752

REMARKS

Claim Status

Claims 18-20, 24-29, 31-32, 34 and 36 are pending in the present application. No additional claims fee is believed to be due.

Claim 21 is cancelled without prejudice.

Independent claims 18 and 28 have been amended. Claim 18 has been amended to include the limitation of cancelled claim 21. Claim 28 has been amended to be more specific about the level of retentive agent in the oral care composition. Support for these amendments is discussed below.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, First Paragraph

The Office Action rejects claims 21, 32, 34, and 36 under 35 USC 112, first paragraph, for failing to comply with the written description. The limitations of claim 21 have been merged into claim 18, and claim 28 has been amended to include the same limitations on the level of retentive agent as claims 32, 34, and 36.

Therefore, Applicants note that no claims, as amended, stand rejected under 102(c) by Lawlor. As such, Applicants will not address that rejection. All that remains is the rejection under 35 USC §112, first paragraph. The Examiner contends that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time of the application was filed, had possession of the claimed invention. Applicants traverse this rejection.

The Office Action states that there is no support for the claimed amount of retentive agent. Applicants respectfully disagree. In amended claim 18, Applicants claim from about 4% to about 15% hydroxyethylcellulose and about 3% to about 10% carboxymethylcellulose. In amended claim 28, and claims 32, 34, and 36, Applicants

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claim about 7% hydroxyethylcellulose and about 4% carboxymethylcellulose. The specification states that the level of the particulate retentive agent may be “from about 1% to about 40%.¹” Therefore, the claimed ranges and amounts are included within the range in the specification and properly supported. *In re Werthem*,² involved the situation where applicants disclosed a range of solids content of 25%-60%, which was held to support a later-claimed range of 35%-60%. The court held that where applicants disclose a range, they have taught possession of all values within that range, all that is necessary for written description under §112. Furthermore, both hydroxyethylcellulose and carboxymethylcellulose are listed on page 8, line 8 of the specification as available retentive agents, including mixtures thereof, page 8, line 12.

In addition, Applicants note that a similar 35 USC § 112, first paragraph rejection was made in the September 7, 2007 Office Action for the co-pending application, application number 10/706103. In their October 19, 2007 response, Applicants argued similarly to that argued above. The Examiner found the argument persuasive and the 112, first paragraph rejection was withdrawn in the July 10, 2008 Office Action of that case. The Examiner and the arguments are the same in the present application as the co-pending application. Therefore, Applicants respectfully request that consistent analysis be conducted, the rejection be withdrawn, and the amended claims be allowed.

Conclusion

This response represents an earnest effort to place the present application in proper form. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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¹ Page 7, lines 31-32.

² 541 F.2d 257, 191 USPQ 90 (CCPA 1976).